

REMARKS

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application.

Claims 1-6 and 8-28 are pending in the subject application. Claims 1, 8 and 28 have been amended for clarification purposes. Support for the amendments to claims 1, 8 and 28 is found throughout the Specification, as filed, and no new matter is presented by the amendment. The Applicant requests that the Examiner enter the instant supplemental amendment to the claims.

1. 35 U.S.C. §112 Rejections

Claims 1-6 and 8-28 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Office asserts that:

Applicant's remarks indicate claim 1's description of (b) is limited to aliphatic diols, aromatic diols and ethylene oxide adducts of aromatic diols. The claim language does not clearly make such a limitation (b) "comprises" two diacids and at least one diol selected from aliphatic/aromatic/EO adducts of aromatic diols. This merely positively requires one of the subsequently named types of diols to be present. It does not prohibit other types of diols to be present. Note that applicant's specification (page 10, line 21) calls for other diols such as cyclohexane dimethanol. Applicant should use language such as "all the diols present are selected from..." instead of "the at least one diol moiety consisting of at least one kind of diol moiety."

Applicants respectfully submit that the claim rejections have been overcome in view of the amendments made herein. In particular, Applicants have amended claim 1 in line with the Examiner's suggestions. Reconsideration and withdrawal of the rejections is respectfully requested.

2. 35 U.S.C. §102/§103 Rejections

Claims 1-6, 8-13, 20, 22, 23 and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Harada. The Office asserts that:

The Harada blends copolyester with polycarbonate in a 2/98 to 95/5 ratio (column 8, line 4). The copolyester has 30-90% of its acid being naphthalene dicarboxylic acid (column 3, line 30). Example 88

and comparison 25 are particularly relevant. Stabilizers (column 5, lines 16-17) can be present.

Further, claims 1-6, 8-15, 20-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Harada in view of Allen and Hirose. The Office asserts that:

Harada does not suggest sterilizing his blend or adding radiation stabilizers.

Allen teaches (column 2, line 26) blends of PC and copolyesters can be sterilized by radiation. Also note, Allen suggests naphthalene dicarboxylic acid units (column 4, line 41) in the copolyester.

Hirose teaches a certain radiation stabilizer for PC/polyester blends (col 7, line 15-20), triazines, phenols (column 7, line 31) and ester lubricants (column 7, line 30) are appropriate inclusions.

It would have been obvious to include any common additive to Harada's blend for the expected advantages and irradiate the final product for sterilization.

Further, claims 1-6, 8-19 and 21-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Harada in view of Mizutani. The Office asserts that:

Harada does not suggest lubricants/release agents for his PC composition. Mizutani lists many release agents known for use with PC (column 5, lines 1-21). Use of any of these fatty acid esters and/or fatty alcohol esters would have been prima facie obvious.

Mizutani also teaches PC is radiation sterilizable with the inclusion of polyester radiation stabilizers and phosphates (column 5, line 22).

Applicants respectfully traverse.

Applicants claim, in claim 1, a thermoplastic resin composition comprising a transparent aromatic thermoplastic resin (a) and a copolyester resin (b). Copolyester resin (b) comprises at least two kinds of dicarboxylic acid moieties and at least one kind of diol moiety. All of the diol moieties are selected from the group consisting of aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof. 1 to 50 mol % of the dicarboxylic acid moieties are a naphthalenedicarboxylic acid moiety. Further, the ratio of (a) to the combined amount of (a) and (b) is 55 to 99.99% by weight, and the ratio of (b) is 0.01 to 45% by weight. Further, the transparent aromatic thermoplastic resin (a) shows a visible light transmittance of not less than 80% when molded into a 3 mm thick product.

The Harada reference, on the other hand, describes copolyesters in which the diol repeat unit is a mixture of ethylene glycol and 1,4-cyclohexanedimethanol repeat units. Thus, all of the resins recited by Harada require at least one alicyclic diol. As set out in claim 1, alicyclic diols are not included in the types of diol moieties.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is clear from the foregoing remarks that the above-identified claims are not anticipated by the Harada reference. In particular, all of Applicants diol moieties are selected from aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof. Harada does not describe, either expressly or inherently, the diol moieties set forth in Applicants' claim 1. Rather, as set out above, Harada requires that at least one diol moiety is an alicyclic diol. Thus, claim 1 is not anticipated by Harada. Claims 2-6 and 8-28 depend from claim 1 and, likewise, are not anticipated by Harada.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142.

As set forth above, Harada does not teach or suggest all the claim limitations. Further, there is absolutely no suggestion or motivation to modify the Harada reference in accordance with Applicants' claim 1.

Applicants further submit that the present claims are patentable over Harada, taken alone or in combination with Allen, Hirose and Mizutani.

As set out above, all of Applicants diol moieties are selected from aliphatic diol moieties, aromatic diol moieties, ethylene oxide adducts of aromatic diol moieties and combinations thereof. Harada does not describe, either expressly or inherently, the diol moieties taught by Applicants. Rather, as set out above, Harada requires that at least one diol moiety is an alicyclic diol.

Further, Allen, Hirose and Mizutani do not remedy the deficiencies of the Harada reference. Rather, Allen, Hirose and Mizutani are cited merely to show methods of stabilizing polycarbonate/polyester blends.

Accordingly, claim 1 is patentable over Harada in view of Allen, Hirose and Mizutani. Claims 2-6 and 8-28 depend from claim 1 and, likewise, are patentable over Harada in view of Allen, Hirose and Mizutani.

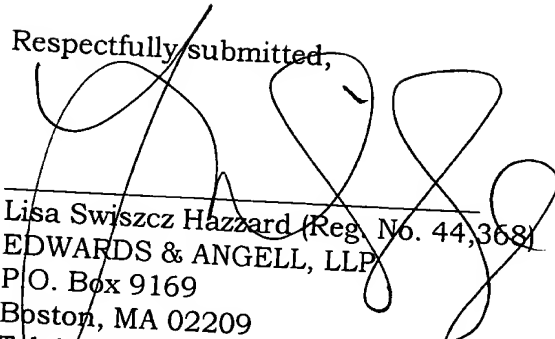
CONCLUSION

In light of the above amendments, Applicant respectfully requests early consideration and allowance of the subject application.

Applicants believe that additional fees are not required in connection with the consideration of the within matter. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Respectfully submitted,



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